



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of

PAI-HSIANG KAO, et al.

Patent No. 6,023,094

Issued: February 8, 2000

Reissue Application No.: 10/022,683

Filed: December 17, 2001

For: **SEMICONDUCTOR WAFER HAVING
A BOTTOM SURFACE PROTECTIVE
COATING**

Group Art Unit: 2815

Examiner: Sheila Clark

**RESPONSE TO OFFICE ACTION
MAILED ON AUGUST 13, 2003**400 Montgomery Street, Suite 1110
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 12, 2003.

GIRARD & EQUITZ LLP

Date: 12/12/03

By: Marsha A. Townsend

Marsha A. Townsend

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed on August 13, 2003 relating to the above-referenced application. In the subject Office Action, all claims were rejected based upon a defective reissue oath. The undersigned attorney requested clarification of this rejection on September 30, 2003 by leaving a telephone voice mail message with Examiner Clark.

On October 6, 2003, Examiner Clark indicated in a voice mail message to the undersigned that she has conferred with a Special Programs Examiner and that, as a result of that conference, the rejection of the reissue oath based upon the grounds set forth in the subject Office Action was being withdrawn. However, the Special

Programs Examiner indicated that there was nothing in the file indicating that the individual who executed the Reissue Application Declaration by Assignee was, in fact, authorized to act on behalf of the Assignee. This grounds of rejection was not raised in the subject Office Action.

Enclosed herewith is an Authorization by Assignee to Execute Reissue Declaration indicating that the individual who executed the Reissue Application Declaration on March 30, 2001, Allen R. Tremain, was authorized to do so. It is submitted that all issues raised by the Examiner have now been addressed.

On October 7, 2003, Examiner Clark indicated in a further voice mail message that she questioned whether there was support in the original patent for language in new Claims 9 and 11 which recite that -- ... the protective film includes laser identification markings ...-- . Presumably, the issue relates to the "written description" requirement of §112, paragraph 1. This grounds of rejection was also not raised in the subject Office Action.

As noted in the document submitted by Applicants entitled **Statement Regarding Claims Pursuant to 37 CFR §1.173(C)**, support for the pertinent language regarding laser markings can be found in the original patent at Column 5, lines 61 - 62 where it is stated that "[t]he protective film provides a surface that may be marked by a laser for identification purposes, for example." There are other references in the patent to laser marking. As understood by the message left by Examiner Clark, these statements refer only to the possibility of laser marking and not to actual marking.

The test for compliance with paragraph 1 of §112 is set forth in the M.P.E.P. as follows:

"The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date

sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.* 935 F.2d at 1563-64, 19 USPQ2d at 1117."

M.P.E.P. at 2100-163.

The M.P.E.P further states:

"While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."

M.P.E.P at 2100-162.

The Examiner appears to have applied an *in hac verba* ("in these words" - an exact correspondence between the language of the claim and the language in the original patent) standard in the present case. As noted in the M.P.E.P section cited above, this is an improper standard. As also noted above, the original patent makes clear that one object of the subject invention is to provide a protective film having a surface suitable to be marked by a laser for identification purposes. There is no question that Applicants were in "possession of the invention as now claimed", including the presence of "laser identification markings" on the protective film surface. This latter limitation is clearly "explicit" in the original patent. At minimum, the limitation is "implicit or inherent" in the original disclosure.

Respectfully submitted,

GIRARD & EQUITZ LLP

Dated: 12/12/03

By: 

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